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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,514	06/26/2003	Daniel A. Wilson	19947-6A	6021
24256	7590	05/31/2005	EXAMINER	
DINSMORE & SHOHL, LLP 1900 CHEMED CENTER 255 EAST FIFTH STREET CINCINNATI, OH 45202			GRAY, JILL M	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/607,514

Applicant(s)

WILSON

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 29-50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a radiation cured encapsulating material, does not reasonably provide enablement for a "radiation cured material". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The language of a "radiation cured material" is broad and encompasses a host of radiation cured materials not supported by the specification, such as reinforced composites and laminates, molded articles, films, and insulated electric conductors, wires and cables. Hence, this language in the claims is not commensurate in scope with the specification.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

### ***Claim Rejections - 35 USC § 103***

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 29-50 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Szum 6,240,230 B1, for reasons of record.

Szum is as set forth previously and teaches a cured material comprising about 20 wt% to about 80 wt% of a polyether based urethane acrylate oligomer, about 20 wt% to about 80 wt% of a monomer diluent and an effective amount of a photoinitiator, as required by claims 33, 36, and 37, wherein said cured material having an elongation at break and modulus within applicants' claimed range. Regarding claims 29-30, because the composition defined by present claims 33-38 further defines the radiation cured material of claim 29, the examiner has reason to believe that a composition that is substantially the same as or similar to that contemplated by applicants in claims 33-38, such as the composition taught by Szum, necessarily results in the requisite tear strength and adhesion force. As set forth previously, products of identical chemical composition cannot have mutually exclusive properties and there is no clear factual evidence on this record that the prior art composition does not necessarily possess the characteristics of the instant claimed product. As to claims 31-32, 42-43, and 48, it should be noted that Szum teaches that proper modulus is important and can be at least about 8 MPa to greater than 25 MPa (column 7, lines 62-67) and that the

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composition can be tailored for different utilities and the modulus adjusted accordingly, such as a modulus of less than about 2,000 psi for single optical fiber coatings. See column 13, lines 64-66. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a radiation cured material of the type contemplated by applicants in present claims 29-50, motivated by the teachings of Szum.

### ***Response to Arguments***

6. Applicant's arguments filed January 10, 2005 have been fully considered but they are not persuasive.

Applicants argue that the examiner's assertion of substantially the same composition is in error, whereby the assumption regarding the claimed properties of tear resistance and adhesion force to an underlying surface material is in error.

In this regard, as set forth previously, it is the examiner's position that because the composition defined by present claims 33-38 further defines the radiation cured material of claim 29, the examiner has reason to believe that a composition that is substantially the same as or similar to that contemplated by applicants in claims 33-38, such as the composition taught by Szum, necessarily results in the requisite tear strength and adhesion force. As set forth previously, products of identical chemical composition cannot have mutually exclusive properties.

Applicants argue that the exemplary compositions of Examples 1 and 2 set forth in the specification exhibiting tear resistance and adhesion force within the ranges recited in claim 29 are not identical to the composition of Szum's Examples 1 and 3, and

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accordingly, there is no basis for assuming that the exemplary compositions of Szum have the same properties, particularly tear resistance and adhesion force, as the composition described in Examples 1 and 2 in the current specification.

In this regard, the specific compositions of applicants' Examples 1 and 2 are not in the claims. The composition of present claims 33-38 is not limited to the specific amounts of applicants' examples, and Szum teaches a composition that substantially overlaps that which applicants regard as their invention in present claims 33-38.

Furthermore, a reference is not limited solely to its preferred embodiments; rather all of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art.

Applicants argue that while there may be overlap between the broad composition disclosed by Szum and the composition limitations recited in one or more of the present dependent claims, for example claim 33, this claim and the additional dependent claims depend from claim 29, and therefore each of these claims first and foremost require the tear resistance and adhesion force recited in claim 29, wherein Szum provides no teaching or suggestion in this regard.

Agreeably Szum is silent as to the tear resistance and adhesion force of his composition. Nevertheless, the presumption is that a composition and its properties are inseparable and the discovery of a previously unappreciated property of a prior art composition does not render the old composition patentably new to the discoverer. Thus the claiming of a new use, new function, or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. It should also

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be noted that there is no factual evidence on this record that the radiation cured material of the prior art does not possess the requisite tear strength and adhesion force.

Applicant argues that the compositions of Szum do not inherently exhibit the properties required by the present claims is evident from the exemplary teachings of Szum, wherein the compositions of Examples 1 and 3 have a modulus of 973 MPa and 740 MPa, respectively, wherein these values are outside of applicants' claimed range.

As set forth previously, all of the disclosures of a reference must be evaluated for what they fairly teach one of ordinary skill in the art. Szum clearly teaches that his composition can have a modulus within applicants' claimed range. Note column 13, line 66.

Applicants argue that the specific teachings of Szum fail to describe, expressly or inherently, each and every element found in claim 29, and the claims dependent thereon and thus does not anticipate the presently claimed radiation cured material.

The examiner disagrees for reasons previously stated and incorporated herein.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray  
Examiner  
Art Unit 1774

jmg